REMARKS

Twenty-six claims were originally filed in the present Application. Claims 11-18 were subsequently withdrawn due to a restriction requirement. 1-10 and 19-26 currently stand rejected. Reconsideration of the Application in view of the following remarks is respectfully requested.

35 U.S.C. § 103

In paragraph 3 of the Office Action, the Examiner rejects claims 1-5, 8-10, 19-22, and 25-26 under 35 U.S.C. § 103 as being unpatentable over Applicants' Admitted Prior Art (hereafter AAPA), in view of Japanese Patent No. 357145345 (hereafter '345) in view of Japanese Patent No. 2001189876 (hereafter '876). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

> "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

With regard to claim 1, the Examiner concedes that AAPA "does not disclose the electronic circuit device coupled to an x-ray shielding layer." Applicants concur. In addition, the Examiner further concedes that '345 similarly "does not disclose the layers are for x-ray shielding." Applicants again concur. The Examiner then points to '876 to purportedly support the rejection of claim 1 because "[t]he '876 reference discloses an x-ray protection circuit."

Applicants respectfully disagree with the Examiner's interpretation of the '876 reference. The '876 reference is limited to disclosing an electronic circuit for handling x-ray radiation, as shown in FIG. 2 of '876. Applicants submit that an electronic circuit comprised of active electronic components, as shown in FIG. 2 of '876, is in no way analogous or similar to Applicants' claimed "x-ray shielding layer". Therefore, for at least the foregoing reasons, the Applicants submit that claim 1 is not unpatentable under 35 U.S.C. § 103 over the cited combination of references, and that the rejection of claim 1 under 35 U.S.C. § 103 is thus improper.

With regard to independent claim 19, the foregoing arguments made with respect to claim 1 apply equally and are hereby incorporated by reference. For at least the foregoing reasons, Applicants therefore respectfully request reconsideration and allowance of independent claims 1 and 19 so that these claims may issue in a timely manner.

Regarding the Examiner's rejection of dependent claims 2-5, 8-10, 20-22, and 25-26, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not

identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of their respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-5, 8-10, 20-22, and 25-26 so that these claims may issue in a timely manner.

Furthermore, with regard to claims 5, 19, 20, 25, and 26, the Examiner concedes that the cited references fail to disclose that "the thickness of the top shield layer is greater than that of the bottom shield." Applicants concur. Then, without citing any further references for support, the Examiner goes on to cursorily conclude that "[i]t would have been obvious . . . to modify the thickness of the bottom/top electrode in order to modify the projection angle of the device in various environments." Similarly, with regard to claims 21 and 22, the Examiner concludes that "it would have been obvious . . . to include spacing ring . . . in order to further secure the base," without cited any additional references in support of the rejections

In the rejections of claims 5, 19, 20-22, and 25-26, it appears that the Examiner is utilizing Official Notice without expressly stating so. Applicants respectfully submit that the limitations of claims 5, 19, 20-22, and 25-26 would not have been obvious to one skilled in the art at the time of the invention. Applicants therefore request the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 5, 19, 20-22, and 25-26, so that these claims may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that there is no teaching of a combination that would result in Applicants' invention, and therefore the rejections of claims 5, 19, 20-22, and 25-26 under 35 U.S.C §103 are not proper. Applicants therefore respectfully request the Examiner to cite references in support of the Official Notice, and to also indicate where an explicit teaching to combine the cited reference may be found.

For at least the foregoing reasons, the Applicants submit that claims 1-5, 8-10, 19-22, and 25-26 are not unpatentable under 35 U.S.C. § 103 over AAPA in view of '345 and '876, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 1-5, 8-10, 19-22, and 25-26 under 35 U.S.C. § 103.

In paragraph 4 of the Office Action, the Examiner rejects claims 6-7 and 23-24 under 35 U.S.C. § 103 as being unpatentable over AAPA, in view of '345 and '876, and further in view of U.S. Patent No. 5,086,443 to Bloch et al. (hereafter Bloch). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima*

facie case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 6-7 and 23-24, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of their respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 6-7 and 23-24so that these claims may issue in a timely manner.

Further with regard to claims 6-7 and 23-24, the Examiner concedes that neither AAPA, '345, nor '876 disclose "shield layers comprising high and low Z materials" as claimed by Applicants. Applicants concur. The Examiner then points to Bloch to purportedly support the foregoing rejections, stating that "Bloch discloses an x-ray mirror comprising high and low Z material." Applicants respectfully disagree with the Examiner's interpretation of Bloch.

Applicants submit that the "mirror" disclosed by Bloch is not analogous to the "radiation shielding top" claimed by Applicants at least because their functionality is significantly different. A mirror operates to reflect radiation, while a shield functions to attenuate radiation. Applicants therefore submit that Bloch

teaches away from Applicants' invention. A prior art reference which teaches away from the presently claimed invention is "strong evidence of nonobviousness." In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed.Cir. 1987).

Also with regard to claims 6-7 and 23-24, the Examiner concludes that "[t]herefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to make the shielding layers with these materials in order to improve their x-ray shielding function." Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention cannot act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that "it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants' structure as a template and selecting elements from references to fill in the gaps." In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

For at least the foregoing reasons, the Applicants submit that claims 6-7 and 23-24 are not unpatentable under 35 U.S.C. § 103 over AAPA in view of '345, '876, and Bloch, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 6-7 and 23-24 under 35 U.S.C. § 103.

Summary

Applicants submit that the foregoing remarks overcome the Examiner's rejections under 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-10 and 19-26 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: 7/29/04

By: _____

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